

### REMARKS

Reconsideration of the Office Action mailed December 6, 2004, (hereinafter "instant Office Action"), and withdrawal of the rejection of claims 1-22 and 38-58, are respectfully requested.

In the instant Office Action, claims 1-60 are listed as pending and claims 1-22 and 38-58 are listed as rejected. Claims 23-27, 59 and 60 are listed as withdrawn from consideration.

Applicants gratefully acknowledge that the Examiner has withdrawn the rejection of claims 1-22 and 38-58 under 35 U.S.C. §102(a,b) as allegedly being anticipated by Duncia et al., U.S. 6,214,851, Sawhney et al., and Bhattacharya et al.

The Examiner has maintained the rejection of claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al., U.S. 2002/0123484 A1. Applicants respectfully traverse this rejection and maintain the arguments presented in the Reply filed September 22, 2004. Applicants have deleted the proviso in claim 1 that was added to remove examples 7 and 8 from Das et al.

In order for an invention to be considered obvious under 35 U.S.C. 103(a), the invention must be considered as a whole, there must be some motivation or suggestion in the prior art reference itself to modify the reference, and there must be a reasonable expectation of success.

The Court of Appeals for the Federal Circuit has stated the following on the issue of obviousness:

*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1051-52, 5 USPQ 1434, 1438 (Fed. Cir. 1988), cert. denied, 109 S. Ct. 75 (1988), on remand, 13 USPQ2d 1192 (D. Conn. 1989) "Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."; *In re Stencel*, 828 F. 2d 751,755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986), cert. dismissed, 108 S. Ct. 26 (1987) "the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability, and thus the obviousness, of making the combination.'"; *Carella v. Starlight Archery*, 804 F. 2d 135,231 USPQ 644 (Fed. Cir. 1986); *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 221 USPQ 929 (Fed. Cir. 1984) "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention,

absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

Donald S. Chisum, Patents, A Treatise on the Law of Patentability, Validity and Infringement, Vol. 2, 5-218, 1992.

The Examiner has not shown how Das et al. renders obvious Applicants' entire genus. Applicants maintain that Das et al. does not render claims 1-22 and 38-58 obvious.

Whether the prior art provides the suggestion or motivation or teaching to select from prior knowledge and combine it in a way that would produce the invention at issue is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). In Applicants' invention, the phenyl ring of the benzothiazole can be unsubstituted or substituted with one or two substituents. Das et al. does not teach or suggest an unsubstituted phenyl ring. The substituent on the phenyl ring in Das et al. which corresponds to Applicants' R<sub>2</sub> is limited to optionally substituted aminoalkyl. In Applicants' genus R<sub>2</sub> is significantly different and can even be an aryl moiety. Further, in Das et al. the substituent corresponding to Applicants' -N(Q)-C(=Y)-NX<sup>1</sup>R<sup>3</sup> moiety is limited to S at Applicants' Y position whereas Applicants have S or O at Y. Das et al. does not provide suggestion or motivation to modify Das et al.'s genus to arrive at Applicants' genus.

Based upon the foregoing, the rejection of claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al. is obviated and should be withdrawn.

The Examiner has objected to claims 1-22 and 38-58 as containing non-elected subject matter heteroaryl or heterocycle, i.e. pyridyl, triazole, furanyl, imidazole, morpholino, pyrrolidine, etc. Applicants respectfully decline the Examiner's suggestion to delete such subject matter at this time. Upon receiving a Notice of Allowability wherein deletion of non-elected subject matter is the only remaining issue Applicants will delete the non-elected subject matter.

No fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

Based upon the foregoing, Applicants believe that claims 1-22 and 38-58 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that there are any issues that could be resolved in a telephone conference, Applicants invite the Examiner to call Applicants' undersigned agent.

Respectfully submitted,

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